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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,861	07/16/2002	Werner Scheler	2267.547US03	6730

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EXAMINER

ESTREMSKY, GARY WAYNE

ART UNIT	PAPER NUMBER
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3676

DATE MAILED: 08/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/020,861

Applicant(s)

SCHELER ET AL.

Examiner

Gary Estremsky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5,6,9,10 and 12-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5,6,9,10 and 12-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 08/649,263.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Reissue Applications

1. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.
2. Claims 5, 6, 9, 10, and 12-25 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

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The non-Final Office Action (Paper No. 13) rejected claims under 35 USC 102(b) in view of U.S.P.N. 3,421,471 to Richter, including examiners statement that claimed container door's "spaced walls" did not patentably define from the perpendicularly-arranged walls of the reference's container door and otherwise indicating claim limitations being anticipated by the prior art. In response to that rejection, the independent claim 9 was amended to include terminology of "and parallel" to further define the container door's walls' arrangement:

"a container door fitted in said container and comprising two walls, spaced apart from and parallel to each other".

Applicant's arguments filed with that amendment specifically indicate that Applicant relies on the new limitation in order to patentably define from the prior art : see page 4 of Applicant's response (Paper No. 15) filed June 25, 1999.

The claim was additionally amended at that time to specifically require that the claimed means for locking and unlocking the claimed container door was located between the two "parallel" walls:

"means for locking and unlocking said container door comprising locking elements provided within said container door between said two parallel walls and being displaceable into a moved-in position and into a moved-out end position and, when moving out, penetrates into said recesses within the container walls".

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Applicant's arguments filed with that amendment specifically indicate that Applicant relies on the new limitation in order to patentably define from the prior art : see page 4 of Applicant's response (Paper No. 15) filed June 25, 1999.

The claim was additionally amended at that time to specifically require specific structural arrangement of claimed locking elements, plates, rotatable disk, and motor:

"every locking element being in the form of a projection from a plate which is directed parallel to the outwardly directed wall of said container door, wherein all plates share a common drive in form of a rotatable disk driven by a motor and acting in the locking and unlocking direction for connecting rods provided for displacing the plates, the plates being fixed in the moved-in end position and in the moved-out end position by said connecting rods".

Applicant's arguments filed with that amendment specifically indicate that Applicant relies on the new limitation in order to patentably define from the prior art : see page 4-5 of Applicant's response (Paper No. 15) filed June 25, 1999.

The claim was additionally amended at that time to specifically require other structural features of the "means for providing a curved path" including

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particulars of that claimed element including its arrangement as regards each of the plurality of plate structures and couplers:

“said means for providing for providing a curved path further comprising structure to maintain and move every [locking element] plate parallel to an outwardly directed wall of said two parallel walls of the container door [and includes] by means of couplers, said couplers for every plate being [connected thereto which are] parallel to each other and [which are] rotatably [supported at the locking element] connected to said plate and also to said outwardly directed wall so that, as a result of the couplers, there is a predetermined distance between [the locking element] every plate and said outwardly directed wall in the moved-in state, which distance decreases during the outward movement until the locking element comes into contact with a contact surface in the recess against which the locking element is pressed in its moved-out end position”.

Applicant's arguments filed with that amendment specifically indicate that Applicant relies on the new limitation in order to patentably define from the prior art : see page 5 of Applicant's response (Paper No. 15) filed June 25, 1999.

Page 6 of Applicant's arguments filed with that amendment (Paper No. 15) of June 25, 1999, indicates that Applicant also relies on the above amendments and each of the specific arguments to overcome the other prior art rejections including rejection under 35 USC 103 in view of Richter '471 and additionally

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Richter '471 in view of U.S.P.N. 1,929,341 to Wegner. As applied against the 35 USC 102 rejections and again against the 35 USC 103 rejections, the arguments relating allowability to each amendment are specifically stated in Applicant's Remarks.

Consequently, the claim(s) was allowed including statement by the examiner that it was the combination of all claim limitations that could not be reconstructed for purpose of prior art rejection less improper use of hindsight, essentially in agreement with Applicant's arguments and conclusion as to teachings of the prior art and allowability of the claim(s) at hand.

Inasmuch as the above-indicated limitations are a result of amendment specifically directed at overcoming prior art rejections, as indicated by Applicant's arguments relating the subject matter of the amendments to the allowability of the invention, that subject matter has been surrendered.

Claims 5, 6, 9, 10, 12-25 do not include all of the above limitations added and relied upon in arguments during Prosecution of the parent and are in effect, broadened in that respect. They do not include the subject matter which was surrendered in the original application in order to obtain the Patent. However, a reissue will not be granted to "recapture" claimed subject matter which was surrendered in an application to obtain the original patent. *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984); *In re Wadlinger*, 496

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F.2d 1200, 181 USPQ 826 (CCPA 1969); *In re Willingham*, 282 F.2d 353, 127 USPQ 211 (CCPA 1960).

Only claims including surrendered subject matter are proper for reissue.
See MPEP 1412.

Response to Arguments

3. Applicant's arguments filed 2/1/05 are essentially the same as those filed 9/1/04 and have been fully considered but they are not persuasive. It's noted that scope of pending claims has essentially removed specific limitations that were added by amendment and argued in Remarks accompanying that amendment in order to patentably distinguish from prior art in the parent Application. It's noted that the surrendered subject matter was not included in the original claims added at the time of filing of the Reissue Application and resulted in a rejection based on 'recapture'. Limitations essentially corresponding to the surrendered subject matter were added after that Office Action and the 'recapture' rejections withdrawn. The amendment filed 9/1/04 again amended the claims but once again removed the surrendered subject matter therefrom. Applicant has provided a diagram as part of the arguments but has not provided any evidence to indicate that present claims are more specific than the scope of the rejected claims' (as indicated by the outer circle in that diagram) whereby those arguments are not persuasive.

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MPEP 1412 describes the surrender of claimed subject matter at length and should be referenced appropriate as part of a response to this Office Action. See MPEP 1412.01 "THREE STEP TEST FOR RECAPTURE". It is the examiner's position that the rejected claims omit *surrendered* ("parallel", for example) limitations as detailed above and are not proper for reissue.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Estremsky whose telephone number is 571 272-7055. The examiner can normally be reached on M-Thur 7:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on 571 272-6843. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gary Estremsky
Primary Examiner
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